

PCT/FF/PFC 15/001
ORIGINAL: FRANCAIS / ENGLISH
SITUATION AT: MARCH 30, 2015
SITUATION AU : 30 MARS 2015

Administrative Instructions Under the Patent Cooperation Treaty (PCT) Standard for the Electronic Filing and Processing of International Applications

Instructions administratives du Traité de coopération en matière de brevets (PCT) Norme concernant le dépôt et le traitement électroniques

PROPOSAL FOR CHANGE FILE/
DOSSIER RELATIF A LA PROPOSITION DE MODIFICATION

SUBJECT: Changes to Annex F, Appendix I, section 3.6 (Modification of the DTD for the PCT fee calculation sheet) SUJET : Modifications de la section 3.6 de l'appendice I de l'annexe F (modification de la DTD de la feuille de calcul des taxes PCT (annexe de la requête))		PROPOSED BY: IB PROPOSÉE PAR : IB	
HANDLING: Expedited cycle TRAITEMENT : Cycle accéléré		PROPOSED DATE OF ENTRY INTO FORCE: 01.07.2015 DATE PROPOSÉE D'ENTRÉE EN VIGUEUR :	
Annex/ Annexe	Content/Contenu	Origin/ Origine	Date
1	Modification of the DTD for the PCT fee calculation sheet to address the requirements for an additional means of payment Modification de la DTD de la feuille de calcul des taxes PCT visant à tenir compte d'un moyen supplémentaire de paiement des taxes	IB	20.01.2015
2	Comments	EP	09.02.2015
3	Comments	CH	20.02.2015
4	Comments	CO	24.02.2015
5	Comments	CL	26.02.2015

6	Comments	CN	27.02.2015
7	Comments	KR	02.03.2015
8	Comments	US	04.03.2015
9	Comments	IB	30.03.2015

Next action:	Entry into force	By:	01.07.2015
Prochaine action :	Entrée en vigueur	Pour le :	

[Annex I follows/
L'annexe I suit]

Item 1	
Location:	Annex F, Appendix I, section 3.6, Fee sheet DTD
Change:	<p>FROM:</p> <pre> <!-- Type(s) of authorization --> <!ELEMENT authorization (total-fee? , deficiency-credit? , fee-for-pdoc?)> <!-- Authoraization to charge the fee for priority document --> <!ELEMENT fee-for-pdoc EMPTY> <!-- Authoraization to charge any deficiency or credit any overpayment --> <!ELEMENT deficiency-credit EMPTY> <!-- Authoraization to charge the total fees indicated above --> <!ELEMENT total-fee EMPTY> TO: <!-- Type(s) of authorization --> <!ELEMENT authorization (total-fee? , deficiency-credit? , fee-for-pdoc?, <u>automatic-debit?</u>)> <!-- Authoraization to charge the fee for priority document --> <!ELEMENT fee-for-pdoc EMPTY> <!-- Authoraization to charge any deficiency or credit any overpayment </pre>

	<pre>--> <!ELEMENT deficiency-credit EMPTY> <!-- Authoraization to charge the total fees indicated above --> <!ELEMENT total-fee EMPTY> <u><!--</u> <u> The Office in its capacity as receiving Office (RO),</u> <u>as International Searching Authority (ISA), and, where</u> <u>applicable, in its capacity as International Preliminary</u> <u>Examining Authority (IPEA) is authorized to</u> <u>automatically debit the identified account with any fees</u> <u>due in the processing of this International Application.</u> <u>--></u> <u><!ELEMENT automatic-debit EMPTY></u></pre>
Reason:	<p>This additional element is to enable a supplemental form of authorization, requested by the European Patent Office that enables a single authorization for PCT fees payment for all fees due during processing of the International application where the receiving Office is also International Authority. It is expected that this element will be used when the payment mode for all prescribed fees is set to “charge” meaning to pay the fees using a deposit or current account held with the Office.</p>

[Annex II follows/
L'annexe II suit]

Comments by the European Patent Office (EPO)

The EPO, having been consulted through the process of authoring the proposal, commented its agreement to the proposal on February 9, 2015.

[Annex III follows/
L'annexe III suit]

Comments by the Swiss Federal Institute of Intellectual Property

The Swiss Federal Institute of Intellectual Property agrees to proceeding with 1441 C.PCT circular.

[Annex IV follows/
L'annexe IV suit]

Comments by the Superintendence of Industry and Commerce of Colombia

Our comment is that we agree on the proposed changes to allow automatic fees online via credit card or automatic debit. The document giving the above is the PCT / EF / PFC 15/001: Changes to Annex F, Appendix I, section 3.6 (Modification of DTD for the PCT fee calculation sheet) Proposal by the International Bureau .

[Annex V follows/
L'annexe V suit]

Comments by Chile

According to the requirements of Circular PCT 1441, concerning proposals for change to the Standard for the Filing and Processing in Electronic Form of International Applications (Annex F of the Administrative Instructions under the PCT) related to the PCT Fee Calculation Sheet (PCT/RO/101 (Annex)), INAPI does not have comments on this issue.

[Annex VI follows/
L'annexe VI suit]

Comments by State Intellectual Property Office of P.R.China

The State Intellectual Property Office of P.R.China has no objection to the proposal concerning changes to Annex F of the Administrative Instructions under the PCT.

[Annex VII follows/
L'annexe VII suit]

Comments by KIPO

We (KIPO) don't have any comments on this issue because we don't use the DTD in our automation system at the present.

[Annex VIII follows/
L'annexe VIII suit]

Comments by USPTO

The following are the USPTO comments regarding Circular C. PCT 1441:

1. The PFC (PCT/EF/PFC 15/001) and the revised DTD are inconsistent. The PFC specifies adding the optional element, "automatic-debit", but the updated DTD (fee-sheet-v1-7draft.dtd) contained the optional element, 'automatic-debit-account', instead as shown in the diagram below and the revision history text from the updated DTD.
2. The revised DTD, fee-sheet-v1-7draft.dtd, still specifies Mr. Bruce Cox and should be changed to Arti Shah: arti.shah@uspto.gov
3. Before approval of the change, we would like to see how it would be implemented on the Conventional Request and on that prepared by PCT-Safe or ePCT.
4. We have some concerns about the blanket authorization:
 - a. As written, the authorization does not prevent an ISA/IPEA from charging additional fees based on a finding of non-unity. We see this as problematic.
 - b. With regard to Chapter II fees, we see the authorization as problematic as some applicants file copies of a Demand with both the desired IPEA and the RO (who may also be a competent IPEA). This may result in two Authorities charging Chapter II fees and the ability to recover those fees may be restricted/limited.

[Annex IX follows/
L'annexe IX suit]

Comments by the International Bureau

The International Bureau would like to express its thanks to the Offices that have reviewed the proposal and provided comments.

In respect of the comments received the international Bureau provided clarifications, listed below, to the four points raised by the USPTO.

Regarding item 1, the error in the draft DTD has been corrected; the element name intended is 'automatic-debit'.

Regarding item 2, we have updated the contact at USPTO to mention Arti Shah (but please note that for the moment, Bruce Cox , is mentioned in the header of all the other DTDs that have not been revised).

Regarding item 3, this PFC has been introduced to support a method of payment that is already used by EPO for regional applications that they wish to extend for PCT applications as they consider that this process assists applicants in simplifying payment processing. As such it is not a payment method that is relevant for other offices and thus we have agreed that we will not update the paper request form – in other-words it is an option available in this form only to applicants at RO/EP using electronic filing (though EPO could of course also implement post-filing procedures to allow applicants filing on paper to make the same indication).

Regarding item 4, regarding concerns regarding the debiting of fees in excess of those anticipated by the applicant, the EPO assured us that in all cases the EPO would be writing to the applicant to give notice of the intention to debit the relevant amount unless the applicant were to contact them within 1 month of the notice. This fee payment mechanism will only be available to Applicants who will file at the EPO (or at other offices that choose to offer this payment method), noting that as the payment method does not appear on the paper request form, it is not a payment method that Offices must support.

In view of the further comments provided by International Bureau the USPTO advised that it could support the proposed changes.

Considering the comments received from PCT member states and with no controversial comments outstanding the International Bureau will adopt the proposal for entry into force on July 1, 2015.

[End Annex IX and of document/
Fin de l'annexe IX et du document]